

REMARKS

This is in response to the Office Action that was mailed on September 19, 2005. Claim 1 is amended to incorporate the recitation of original claim 3, and claim 3 is accordingly cancelled, without prejudice. Claim 1 is also amended to incorporate the recitation of original claim 7, and claim 7 is cancelled without prejudice. The claim 7 recitation is also incorporated into claim 10. Finally, claim 10 is amended to incorporate the recitation of original claim 12, and claim 12 is accordingly cancelled, without prejudice. No new matter is introduced by this Amendment. Claims 1, 2, 4-6, 8-11, and 13-18 are pending in the application, with claims 13-18 being withdrawn from consideration.

Restriction had been required between claims 1-12 and claims 13-18. Applicants confirm the election of the invention of claims 1-12. This requirement for restriction is respectfully traversed, on the ground that it would not be unduly burdensome for the Examiner to examine the invention of claims 13-18 along with claims 1-12.

Oyama alone

Claims 10-12 were rejected as being anticipated by or alternatively as being unpatentable over US 5,651,995 (Oyama). Office Action, pages 3-6. Claims 1, 2, and 5-9 were also mentioned in this rejection. However, since the recitation of non-rejected claim 3 has been incorporated into independent claim 1, this ground of rejection does not apply to claims 1, 2, and 5-9 in their present form.

Inasmuch as claim 10 has been amended to incorporate the recitation of claim now-cancelled 12, the rejection of concern is that which was stated by the Examiner as follows:

As to the content of water to be 1 wt% or less in the adhesive composition ..., in the absence of showing criticality of the record, the optimization value of water content in a known process is within an ordinary skill in the art. *In re Boesch*, [citations omitted].

Office Action, page 6. The Examiner's reliance on the 1980 decision of the CCPA in *In re Boesch*, 205 USPQ 215, is misplaced. In that case, the Applicant had claimed an alloy the recited ranges of which overlapped with the prior art. The court's holding was explained as follows:

In the above-quoted passage from [the prior art patent], we note that lowering the N_v value of a Co-Cr-Ni alloy and deletion of the metals not consumed in precipitation from the N_v calculation are ***expressly suggested***. Considering, also, that the composition requirements of the claims and the cited references ***overlap***, we agree ... that the prior art would have suggested "the kind of experimentation necessary to achieve the claimed composition, including the proportional balancing described by appellants' N_v equation." This accords with the rule that discovery of an optimum value of a result effective variable ***in a known process*** is ordinarily within the skill of the art. [citations omitted.] Accordingly, we conclude that a *prima facie* case of obviousness has been established.

205 USPQ at 219 (emphasis supplied). Here the Examiner does not show that the prior art expressly suggests adjusting the percentage of water in the composition, nor that the prior art teaches water percentages that overlap with those of the present claims and the Applicants have simply discovered what water percentages within the overlapping ranges are optimum. Clearly, the *Boesch* decision is inapposite to the present situation. Applicants respectfully disagree with the Examiner that the skilled artisan would recognize the water content in the claimed adhesive compositions as a "result effective variable". Based on the teachings of Oyama, the modification of the water content to the recited range would not be obvious, since any such experimentation

would not have come from within the teachings of the art. *In re Fay*, 347 F.2d 597, (CCPA 1965). In determining whether or not such experimentation is within the teachings of the art, the Examiner “must be ever alert not to read obviousness into an invention on the basis of the [Applicants’] own statements; that is, we must view the prior art without reading into that art [Applicants’] teachings.” *In re Sponnoble*, 405 F.2d 578, (CCPA 1969). Clearly, the Oyama reference neither teaches nor suggests the inventions of present claims 10 and 11.

Oyama in view of Kotsuji

Claims 3 and 4 were rejected as being unpatentable over Oyama in view of WO01/127199 A1 and US 6,548,604 B1 (collectively, Kotsuji). Independent claim 1 now recites the compositional distribution breadth feature of claim 3. Independent claim 1 also now recites the particle size feature of claim 7.

On page 5 of the Office Action, the Examiner appears to acknowledge that the prior art does not teach the presently recited particle size range of original claim 7. The Examiner argues, however, that it is well known the particle size distribution is **controllable** by nucleation process, choice and amount of surfactant, temperature and other reaction variables, and the use of seed emulsion polymerization. What the Examiner appears to be saying in this analysis is that the present invention is *prima facie* obvious because a person of ordinary skill in the art **could** carry it out. “The mere fact that a reference **could be** modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art.” *Libbey-Owens Ford Co. v. BOC Group Inc.*, 655 F. Supp. 897, 906, 4 USPQ2d 1097, 1103 (D.N.J. 1987) (emphasis supplied). “Something in the prior art as a whole must suggest the **desirability** ... of

making the combination.” *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051-52, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) (emphasis supplied). “The mere combination of prior art references does not make an invention obvious unless something in the prior art suggests or reasonably implies an *advantage to be derived* from uniting their teachings.” *Creative Pioneer Products Corp. v. K-Mart Corp.*, 5 USPQ2d 1841, 1844 (S.D. Tex 1986) (emphasis supplied).

The Examiner goes on to say: “in absence of showing criticality of the record, the optimization value of particle size ranging from 50 to 150 μm in a known process is within an ordinary skill in the art. *In re Boesch*”. As in the rejection discussed above, the Examiner’s reliance on *Boesch* is misplaced in this rejection also. In *Boesch*, the Applicant had claimed an alloy the recited ranges of which overlapped with the prior art. The court’s holding was explained as follows:

In the above-quoted passage from [the prior art patent], we note that lowering the N_v value of a Co-Cr-Ni alloy and deletion of the metals not consumed in precipitation from the N_v calculation are *expressly suggested*. Considering, also, that the composition requirements of the claims and the cited references *overlap*, we agree ... that the prior art would have suggested “the kind of experimentation necessary to achieve the claimed composition, including the proportional balancing described by appellants’ N_v equation.” This accords with the rule that discovery of an optimum value of a result effective variable *in a known process* is ordinarily within the skill of the art. [citations omitted.] Accordingly, we conclude that a *prima facie* case of obviousness has been established.

205 USPQ at 219 (emphasis supplied). Here the Examiner does not show that the prior art expressly suggests adjusting particle size in the composition, nor that the prior art teaches particle sizes that overlap with those of the present claims and the Applicants have simply discovered what particle sizes within the overlapping ranges are optimum. *Boesch* does not apply here. Based on the teachings of Oyama and Kotsuji (and Principles of Polymerization),

the modification of particle size to the recited range would not be obvious, since any such experimentation would not have come from within the teachings of the art. *In re Fay*, 347 F.2d 597, (CCPA 1965). In determining whether or not such experimentation is within the teachings of the art, the Examiner "must be ever alert not to read obviousness into an invention on the basis of the [Applicants'] own statements; that is, we must view the prior art without reading into that art [Applicants'] teachings." *In re Spinnoble*, 405 F.2d 578, (CCPA 1969). Clearly, the Oyama reference neither teaches nor suggests the inventions of present claims 1, 2, 4-6, 8, and 9.


Conclusion

The Examiner is respectfully requested to confirm that the rejections of record do not apply to the claims herein in their present form.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at (703) 205-8008.

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Respectfully submitted,

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